



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/582,074

03/16/2007

Peter Quirk

HAC-104US

1552

23122 7590 05/22/2009
RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

EXAMINER

FONSECA, JESSIE T

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

05/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,074	Applicant(s) QUIRK, PETER	
	Examiner JESSIE FONSECA	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/8/06 and 8/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 15: The claim is indefinite as the leg spacing is being defined by the member, which is not a positively claimed element.

With regards to claim 23: The claims is directed to an apparatus, however, claim 23 is indefinite as it appears to recite a method step of removing portions of the flashing. Further, the claim includes the limitation "wing(s) and/or legs(s)", it's unclear as to the number wings and/or legs the flashing comprises.

Claims 15 and 23-25 are examined as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Weir (US 5,148,644).

With regards to claim 1: Weir discloses flashing (30') comprising an elongate body capable of overlying a member, and the flashing further comprising legs (A) extending for at least part of the body length and protruding from either side of the body (fig. 5)

The flexible flashing of Weir has a configuration prior to overlying the member whereby one or both legs is/are capable of being biased towards a respective member side when positioned thereat.

Note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

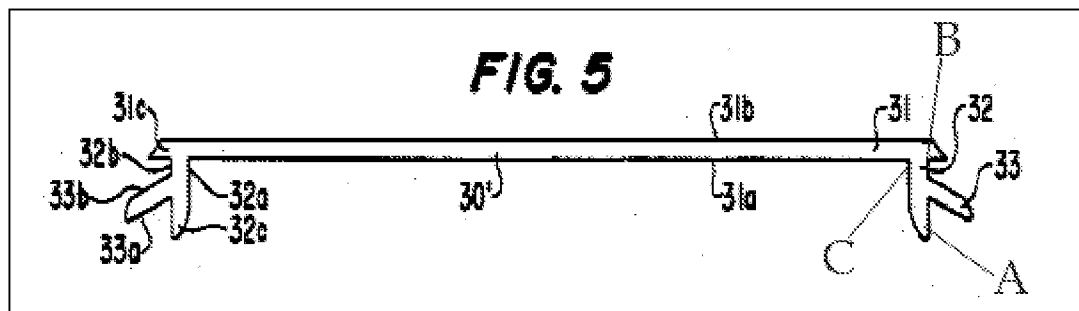


Fig. 5: Weir (US 5,148,644)

With regards to claim 2: Weir further discloses two legs (A) extending for the entire length of the body on opposing sides thereof (figs. 57).

With regards to claim 4: Weir further discloses wings (31C) extending laterally from the body beyond the legs (A) (figs. 5 & 7).

With regards to claim 5: Weir further discloses the wings (31C) extend for the entire length of the body on opposing sides thereof (figs. 5 & 7).

With regards to claim 6: Weir further discloses a line (B) provided along and adjacent to where each wing (33) is attached to the body.

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it is capable of being severed along that line.

With regards to claim 7: Weir further discloses the wings (31c) have an elongate rectangular shape on the bottom face of the wings and are respectively joined to the body along opposing elongate sides thereof (fig. 5).

With regards to claim 8: Weir further discloses each wing (33) tapers, from a relatively thicker section where it is connected to the body to a relatively thinner remote end (fig. 5).

With regards to claim 9: Weir further discloses a line (C) provided along and adjacent to where each leg is attached to the body.

Each leg of Weir is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line.

With regards to claim 10: Weir further discloses the body has an elongate rectangular shape (fig. 2).

With regards to claim 11: Weir further discloses the legs (A) have an elongate rectangular shape on the outer face and are joined to the body along opposing elongate sides thereof.

With regards to claim 12: Weir further discloses each leg (A) tapers, from where it is connected to the body to a remote end.

With regards to claim 13: Weir further discloses flashing is formed from an elastomeric material (rubber) (col. 1, lines 52-56).

With regards to claim 14: Weir further discloses the member is a joist, beam, bearer, wall plate, rafter or batten. Note claims are directed to the flashing, the member is not a positively claimed element.

With regards to claim 15: The legs of Weir are capable of being spaced at approximately the width of the member (fig. 6).

With regards to claim 17: Weir discloses flashing (30') comprising an elongate body for overlying a member, and legs (A) protruding from either side of the body and extending for at least part of the body length (fig. 5).

Each leg of Weir is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line (B) of Weir is considered to read on the claim as it capable of severed along that line.

With regards to claim 18: Weir discloses flashing comprising an elongate body for overlying a member, and wings (31c) extending laterally from either side of the body and extending for at least part of the body length (figs. 5 & 7).

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line.

With regards to claims 19-20: Weir discloses a line (B, C) provided along and adjacent to where each leg or wing is attached to the body.

Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of being severed along that line.

Claims 1-4 and 6-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sykes (WO 91/13221).

With regards to claim 1: Sykes discloses “flashing” (186b) comprising an elongate body capable of overlying a member, and the flashing further comprising legs (184) extending for at least part of the body length and protruding from either side of the body (fig. 8; pg. 11, lines 15-28)

The “flashing” of Weir has a configuration prior to overlying the member whereby one or both legs is/are capable of being biased towards a respective member side when positioned thereat.

Note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

Art Unit: 3633

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

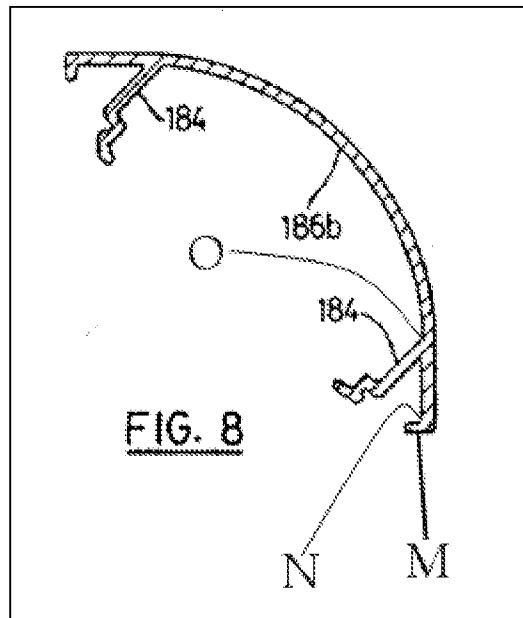


Fig. 8: Sykes (WO 91/13221)

With regards to claim 2: Sykes further discloses two legs (184) extending for the entire length of the body on opposing sides thereof (fig. 8).

With regards to claim 3: Sykes further discloses prior installation, the legs (184) on opposing sides of the body project generally towards each other (fig. 8).

With regards to claim 4: Sykes further discloses wings (M) extending laterally from the body beyond the legs (184) (fig. 8).

With regards to claim 6: Sykes further discloses a line (N) provided along and adjacent to where each wing (N) is attached to the body.

Each wing of Sykes is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite

Art Unit: 3633

the structure of the line of severance. Accordingly, the line of Sykes is considered to read on the claim as it capable of being severed along that line.

With regards to claim 7: Sykes further discloses the wings (M) have an elongate rectangular shape and are respectively joined to the body along opposing elongate sides thereof (fig. 8).

With regards to claim 8: Sykes further discloses each wing (M) tapers, from a relatively thicker section where it is connected to the body to a relatively thinner remote end (rounded edge) (fig. 5).

With regards to claim 9: Sykes further discloses a line (O) provided along and adjacent to where each leg is attached to the body (fig. 8)

Each leg of Sykes is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line of Weir is considered to read on the claim as it capable of severed along that line.

With regards to claim 10: Sykes further discloses the body has an elongate rectangular shape from the perspective of top view (fig. 8) similar to that of applicant's.

With regards to claim 11: Sykes further discloses the legs (184) have an elongate rectangular shape on several faces and are joined to the body along opposing elongate sides thereof.

With regards to claim 12: Sykes further discloses each leg (184) tapers (rounded edge), from where it is connected to the body to a remote end.

With regards to claim 14: The “flashing” of Sykes is capable of being disposed on a joist, beam, bearer, wall plate, rafter or batten. Note claims are directed to the flashing, the member is not a positively claimed element.

With regards to claim 15: The legs of Sykes are capable of being spaced at approximately the width of a member (fig. 6).

With regards to claim 16: Sykes further discloses the body is provided with a contoured profile, with the legs (184) extending inwardly from a concave surface of the body. The body of Sykes is capable of assuming a generally flat configuration when the “flashing” is located on a member as it is made of a thin resilient material (pg. 11, lines 15-28).

With regards to claim 17: Sykes discloses “flashing” (186b) comprising an elongate body for overlying a member, and legs (184) protruding from either side of the body and extending for at least part of the body length (fig. 8).

Each leg of Sykes is capable of be severed along and adjacent to where each leg is attached to the body to enable leg detachment. Note the claim does not recite the structure of the line of severance. Accordingly, the line (O) of Sykes is considered to read on the claim as it capable of being severed along that line.

With regards to claim 18: Sykes discloses flashing comprising an elongate body for overlying a member, and wings (M) extending laterally from either side of the body and extending for at least part of the body length (figs. 8).

Each wing of Weir is capable of be severed along and adjacent to where each wing is attached to the body to enable wing detachment. Note the claim does not recite

Art Unit: 3633

the structure of the line of severance. Accordingly, the line (N) of Sykes is considered to read on the claim as it capable of being severed along that line.

With regards to claims 19-20: Weir discloses a line (N, O) provided along and adjacent to where each leg or wing is attached to the body.

Note the claim does not recite the structure of the line of severance. Accordingly, the line of Sykes is considered to read on the claim as it capable of being severed along that line.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Knoche (DE 37 30 758 A1).

With regards to claim 1: Knoche discloses flashing comprising an elongate body for overlying a member, and legs (211, 214) extending for at least part of the body length and protruding from either side of the body (figs. 2-3).

The flashing of Knoche has a configuration prior to overlying the member whereby one or both legs is/are capable of being biased towards a respective member side when positioned thereat.

Note a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 103

Art Unit: 3633

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoche (DE 37 30 758 A1).

With regards to claims 22-23: Knoche discloses an arrangement between the roof membrane formed roofing tile and roof ridge bricks wherein flashing as claimed in claim 1 is mounted to an in use upper surface of a roof such that the flashing of one member overlaps the flashing of another (claim 1 of Knoche).

Knoche does not explicitly disclose the flashing mounted on the upper surface of a first and second member. However, given the disclosure of Knoche, one of ordinary skill in the art would recognize the flashing (sealing members) of Knoche would extend along the roof ridge plank (F) for proper sealing of the roof. Accordingly, the flashing of Knoche would be mounted over the roof membrane formed roofing tile.

With regards to claim 24-25: As per the modification, the arrangement would define a butt joint between the first and second members (tile and roof ridge plank, F).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited is directed to coverings for various building elements/members.

Art Unit: 3633

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./
Examiner, Art Unit 3633

/Robert J Canfield/
Supervisory Patent Examiner, Art Unit 3635